

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM C. DODT, JERRY L. DONZE, JOHN C. OWENS,
BRIAN P. EGAN, RALPH L. BUTTS,
and DONALD R. SCHENCK

Appeal No. 1998-2017
Application No. 08/802,216

ON BRIEF¹

Before BARRETT, DIXON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of Claims 13-24, which are all the claims remaining in the application.

We reverse.

¹Appellants waived oral hearing in the fax communication filed October 3, 2000 (Paper No. 34).

BACKGROUND

The disclosed invention is directed to a system and method for selectively routing data read from a magnetic tape to a computer or to a video subsystem, depending upon whether the data are of a computer or a video data type. Representative Claim 13 is reproduced below.

13. A system having a control unit that controllably interconnects a tape drive with a computer means and a video means;

said tape drive comprising means for reading magnetic tapes each containing a single one of a plurality of different data types along substantially the entire length of each said magnetic tape;

each said magnetic tape containing a header when said data type on said each magnetic tape represents computer data and being devoid of a header when said data type on each said magnetic tape represents video data;

said control unit comprising:

means responsive to a single reading of a portion of each said magnetic tape for detecting a presence or an absence of a header on said portion of each said magnetic tape;

means for selectively routing data read from each said magnetic tape to said computer means in response to a detection of said presence of a header on each said magnetic tape; and

means for selectively routing said data read from each said magnetic tape to said video means in response to a detection of said absence of a header on each said magnetic tape.

The examiner relies on the following references:

Bar

5,268,802

Dec. 7, 1993

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Yokota et al. (Yokota) 5,452,279

Sep. 19, 1995
(filed Mar. 19, 1993)

PCT Publication WO 93/20647 (Moss), published Oct. 14, 1993

Claims 13-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bar in view of Yokota and Moss.

We refer to the Final Rejection (Paper No. 18) and the Examiner's Answer (Paper No. 28) for a statement of the examiner's position and to the Brief (Paper No. 27) and the Reply Brief (Paper No. 31) for appellants' position with respect to the claims which stand rejected.

OPINION

The examiner bears the initial burden of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant. After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The examiner refers to Bar as disclosing a tape drive that reads both standard and non-standard format tapes. The examiner relies on Yokota as teaching a header detection circuit. (See Answer, pages 3 and 4.)

Appellants' view, however, is that the "reference bursts" disclosed by Bar are within the meaning of "header" as claimed. (See Brief, page 14.) Since Bar teaches discriminating standard from non-standard format tapes based upon sensing the presence or absence of the "reference bursts," the Yokota reference (disclosing circuitry in an optical disk drive) becomes a mere cumulative reference in the instant rejection. Appellants admit that the teaching from Yokota upon which the examiner relies is present in the Bar reference.

The examiner turns to the Moss reference, and the "data communication device" disclosed therein, for a showing of selectively routing data "from a magnetic tape to a computer port 16 and a video port 14." (Answer, page 5.) In the examiner's opinion, the fax disclosed by Moss is a "video means" as presently claimed.

Appellants argue, inter alia, that the "Moss scanner or fax machine is not equivalent under 35 U.S.C. § 112, ¶ 6, to claimed 'video means' as defined in the specification of Appellants' Application." (Brief, page 9.) As appellants point out, the specification's description corresponding to the claimed "video means" is that of a video system for continuous playback, which retrieves video data from a magnetic tape.

Although the use of the term “means” in the recitation of “video means” triggers a presumption that the statutory procedures of 35 U.S.C. § 112, sixth paragraph apply (see, e.g., Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1584, 39 USPQ2d 1783, 1787 (Fed. Cir. 1996)), the mere use of the term is not conclusive. The claims do not set forth any function that is associated with the video means (except, perhaps, the implicit function of receiving data from a magnetic tape, which is not a “video” function). We therefore interpret the “video means” without reference to section 112, sixth paragraph. See York Prod., Inc. v. Central Tractor Farm & Family Center, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1624 (Fed. Cir. 1996)(“Without a ‘means’ sufficiently connected to a recited function, the presumption in use of the word ‘means’ does not operate.”).

However, we agree with appellants to the extent that appellants’ argument stands for the proposition that the artisan would not have interpreted “video means” as inclusive of a conventional fax machine, as disclosed by Moss. Appellants’ disclosure does not attach any special definition to the word “video” that is different from its ordinary, accepted meaning. Appellants use the word “video” in the sense of referring to video playback as on a video terminal, consistent with the dictionary definition: “video...2: being, relating to, or involving images on a television screen or computer display <~ terminal>.” Webster’s Ninth New Collegiate Dictionary, 1990 ed.²

² Copy attached to this decision.

Appellants also argue that “[t]he prior art in the rejection does not teach or suggest a tape drive which read[s] tapes containing video data and tapes containing computer data.” (Brief, page 8.) We agree. The teachings of the references are not sufficient to support the asserted conclusion of obviousness. Both independent Claim 13 and independent Claim 19 require selectively routing data from magnetic tape to computer means or video means in response to detection of presence or absence of a header on the magnetic tape.

As the examiner points out (Answer, page 5), the Abstract of Moss discloses that the “nature of an incoming message” is identified by the presence or absence of a header that has been attached “by a similar device which is transmitting.” However, in the context of Moss, “header” refers to information accompanying electronic communications transmitted over phone lines -- the “fax and/or digital data” as stated in the Moss Abstract. Such a “header” is absent in voice communications and fails to trigger the machine-to-machine protocols disclosed by Moss, so that the apparatus does not interfere with voice communications. In any event, the rejection does not explain how the statement in the Moss Abstract is deemed to support the conclusion of obviousness of the claimed subject matter.

Moss suggests, at page 2, that RAM 10 (which serves as a bi-directional memory buffer) may be replaced or expanded with magnetic tape. We do not agree with appellants’ assessment, as set forth on page 10 of the Brief, that this portion of the Moss

disclosure is “non-enabling,” or precludes data routed “from” the tape. However, it appears that at most Moss suggests selectively routing computer data or fax data from a magnetic tape. Even if the fax machine could be considered a “video means,” and the fax data could be considered “video data,” the data would not be routed to the fax in response to a detection of the absence of a header on the magnetic tape, as required by independent Claims 13 and 19.

Finally, appellants argue that the prior art does not support the assertion that it was “notoriously well known” that computer tapes had headers while video tapes did not (see Brief, page 13). The examiner merely repeats the bare assertion on page 4 of the Answer without providing any evidentiary support. The fact alleged appears to relate to the state of the art, or to esoteric knowledge in the art, rather than to a matter of general knowledge of which official notice may be taken, and should have been supported by a showing from the prior art in the first instance. See, e.g., In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (CCPA 1970)(allegations concerning specific “knowledge” of the prior art, which might be peculiar to a particular art should be supported and the appellant given the opportunity to make a challenge). In any event, appellants challenged the assertion. The burden was on the examiner to provide evidence in support, which burden was not met.

For the foregoing reasons we conclude that the rejection fails to set forth a prima facie case for obviousness of the claimed subject matter as a whole. There is another matter, however, that requires attention. The examiner cited a reference “not relied upon”

on page 5 of the Final Rejection -- U.S. Patent 5,566,032 (Cleveland). The examiner agreed in the Answer (page 2) that there was an “alternative 35 U.S.C.

§ 103(a) rejection over Cleveland...in view of Moss,” as stated by appellants on page 5 of the Brief. Indeed, the examiner listed Cleveland as a reference “relied upon” on page 2 of the Answer.

However, the statement of the rejection in both the Final Rejection and the Answer does not include Cleveland. All references used in a rejection should be clearly included in the initial statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970)(“Where a reference is relied on to support a rejection, whether or not in a ‘minor capacity,’ there would appear to be no excuse for not positively including the reference in the statement of rejection.”). Moreover, it appears that the teachings of Cleveland form no part of the rejection on appeal, not even in some “minor” capacity. We thus do not view Cleveland as a reference in the rejection applied against the claims, and have not considered the reference in reaching our determinations in the instant appeal.

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CONCLUSION

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The rejection of Claims 13-24 is reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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